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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 08/870,591 | 06/06/97 | ESCH | H 08594327 |

IM51/0608

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EXAMINER
HENDRICKSON, S

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
| 1754 | 17 |

DATE MAILED: 06/08/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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|------------------------------|---------------------------------------|------------------------------------|
| Office Action Summary | Application No. 08/870,591 | Applicant(s) Esch et al. |
| | Examiner Stuart Hendrickson | Group Art Unit 1754 |

Responsive to communication(s) filed on Mar 20, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1 and 7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1 and 7 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) 08/594,327.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) In claim 1 lines 7-8, "ml ... pH of 7" is unclear since it varies as the NaOH concentration varies. It is not clear exactly to what values the claim is limited.
- b) In line 12 of claim 1, V_1 and V_2 are not defined.

Claims 1 and 7 are rejected under 35 U.S.C. § 103 as obvious over Lagarde et al.

The reference teaches in col.2 lines 5-35 and col.9 lines 1-10 silica having BET 242, CTAB 237, BET/CTAB=1.02. The pore and silanol density properties claimed but not discussed by Lagarde are deemed possessed by the product of Lagarde since the BET, CTAB and the ratio thereof are indicative of the structure of the material and are the same as claimed.

Lagarde differs in the "aggregate" (ie particle) size. However the general values disclosed in col. 2 lines 1-35, of a particle size of essentially less than 45 microns subsumes the claimed size range.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held

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to be obvious to select a value in a known range by optimization for the best results, see *In re Aller et al.*, 105 U.S.P.Q. 233.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Johnson et al.* (4681750).

Johnson teaches in col. 2 line 25-col. 3 line 5 and col. 5 lines 35-68 precipitated silica having BET in the claimed range, made in a manner substantially the same as disclosed. An alkali silicate is acidified at the disclosed temperature to the same pH, continuing the reaction for a desired time period and acidifying again to the same disclosed lower pH. The product is then washed and dried, as disclosed. Even though the claimed physical properties are not disclosed by *Johnson*, the product thereof is deemed to possess them nonetheless since it was made in essentially the same manner as instantly disclosed.

Note that where the examiner has evidence that the product of the reference is the same as claimed but cannot determine whether all the properties are possessed, the burden is upon the applicant to show a difference; *In re Fitzgerald et al.* 205 USPQ 594.

Any inquiry concerning this communication should be directed to examiner *Hendrickson* at telephone number (703) 308-2539.



Stuart Hendrickson
examiner Art Unit 1754